



Attorney Docket No.: 5904.214-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Malmlof et al.

Serial No.: 10/772,997

Group Art Unit: To be assigned

Filed: February 5, 2004

Examiner: To be assigned

For: Use of a Growth Hormone or a Growth Hormone Secretagogue for Appetite-Suppression
or Induction of Satiety

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached correspondence comprising:

1. Response to Notice Of Incomplete NonProvisional Application (in duplicate)
2. Copy of Notice Of Incomplete NonProvisional Application

is being deposited with the United States Postal Service as first class mail in an envelope
addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on May 18, 2004

Rashida Haji
(name of person mailing paper)

Rashida Haji
(signature of person mailing paper)



\$ DAE
JTW

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USSN: 10/772,997
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In re Application of: Malmlof et al.

Application No.: 10/772,997

Group Art Unit: Not Assigned

Filed: February 5, 2004

Examiner: Not Assigned

For: USE OF A GROWTH HORMONE OR A GROWTH
HORMONE SECRETAGOUGE FOR APPETITE-SUPPRESSION
OR INDUCTION OF SATIETY

PETITION TO ACCORD A FILING DATE UNDER 37 C.F.R. § 1.53(e)

Commissioner for Patents
Mail Stop Petitions
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice Of Incomplete Nonprovisional Application dated May 6, 2004, (copy attached), Applicants hereby petition the Office to accord the filing date of February 5, 2004 to this patent application pursuant to 37 C.F.R. § 1.53(e) and 37 C.F.R. § 1.181.

The US Patent and Trademark Office (hereinafter "the Office") issued a Notice of Incomplete Nonprovisional Application on May 6, 2004 (hereinafter "the Notice"). The Notice indicates that this patent application has not yet been accorded a filing date due to the failure to deposit the application with drawings.

Although this patent application refers to figures which were not included with the copy of the application filed on February 5, 2004, this application should still be accorded that filing date for at least two reasons.

05/24/2004 AWONDAF1 00000038 141447 10772997

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First, this application incorporates by reference U.S. Patent Application No. 10/140,512, which contains identical copies of the referenced figures and description thereof. Applicants note that the subject application is a continuation of the '512 application. This application is identical to the '512 application in the specification (modifications in the claims of this application are fully supported by the text of the '512 application). Under Office policy, information incorporated by reference is considered "as much a part of the application as filed as if the text was *repeated in the application*, and should be treated as part of the text of the application *as filed*." See, e.g., MANUAL OF PATENT EXAMINING PROCEDURE (hereinafter "MPEP") § 2163.07(b) (emphasis added). Accordingly, Applicants request that this application be accorded the filing date of February 5, 2004, and that the figures of the '512 application be considered in the examination of this application. If necessary, Applicants' representative can submit a formal affidavit regarding the incorporation of this material.

Second, in the event the Office deems the incorporation of this material ineffective for according this application the February 5, 2004 filing date, Applicants, *alternatively* request that this application be accorded that filing date due to the fact that the referenced figures, while beneficial in illustrating Applicants' invention, are not necessary to understanding the claims of this application and, accordingly, are not required under 35 U.S.C. § 113 (hereinafter "Section 113") (see also MPEP § 601.01(f) for discussion of related principles). Specifically, the claims of this application are directed to methods of suppressing appetite (1-7 and 14-16), preventing diseases or disorders (8-13), and a composition formulated for injection (17). None of the claims are directed to any subject matter that relies upon the content of the "missing" figures for support. Applicants note that "It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence)." See MPEP § 601.01(f). "The same practice has been followed in composition applications." *Id.* The claims of this application fall within these categories and do not require the drawings for support. Accordingly, even if the Office should not accord this application the February 5, 2004 filing date based upon the

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USSN: 10/772,997
Filed: February 5, 2004

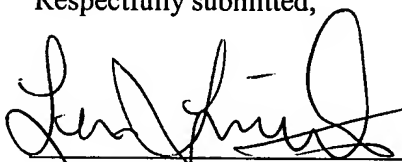
incorporation of the parent '512 application, it should do so based on the nonnecessity of the figures under Section 113. Applicants strongly believe that the Office should accord this application the February 5, 2004 filing date due to the incorporation and *only* wish to rely on this alternative request *if absolutely necessary* to accord the application the February 5, 2004 filing date.

For the foregoing reasons, Applicants respectfully request that this application be accorded the filing date of February 5, 2004, and that examination of this application thereafter proceed on the merits. To the extent permissible, Applicants also request permission to submit copies of the figures incorporated by the reference to the parent '512 application in this application and that the Examiner considers such figures in the examination of this application.

Please charge the required fee (under 37 C.F.R. § 1.17(h)), estimated to be \$130.00, to Novo Nordisk Pharmaceuticals, Inc., Deposit Account No. 14-1447. A duplicate of this sheet is enclosed. Upon grant of this Petition, Applicants respectfully request a refund of this fee, which may be made by deposit to this Deposit Account.

Respectfully submitted,

Date: May 18, 2004

A handwritten signature in black ink, appearing to read 'Len S. Smith', written over a horizontal line.

Len S. Smith, Reg. No. 43,139
Novo Nordisk Pharmaceuticals, Inc.
100 College Road West
Princeton, NJ 08540
(609) 987-5800

Use the following customer number for all correspondence regarding this application

23650

PATENT TRADEMARK OFFICE



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/772,997	02/05/2004	Kjell Malmlof	5904.214-US

23650
NOVO NORDISK PHARMACEUTICALS, INC
100 COLLEGE ROAD WEST
PRINCETON, NY 08540

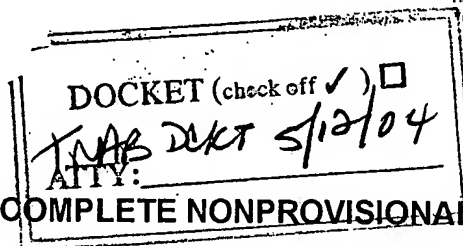
CONFIRMATION NO. 5384

FORMALITIES LETTER



OC000000012532209*

Date Mailed: 05/06/2004



NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

A filing date has NOT been accorded to the above-identified application papers for the reason(s) indicated below.

All of the items noted below and a newly executed oath or declaration covering the items must be submitted within TWO MONTHS of the date of this Notice, unless otherwise indicated, or proceedings on the application will be terminated (37 CFR 1.53(e)). Replies should be mailed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the item(s) required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$130.00 petition fee (37 CFR 1.17(h)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

- The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented." Applicant should reconsider whether the drawings are necessary under 35 U.S.C. 113 (first sentence).

MAY 10 2004

Replies should be mailed to: Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*

AG
Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY